

REMARKS

This Amendment is submitted in response to the Office Action dated March 25, 2004, having a shortened statutory period set to expire June 25, 2004. In the present Amendment, Claims 13 and 19 are cancelled. Claims 13-21 are now pending.

REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

In paragraph 3 of the present Office Action, Claims 13 and 19 are rejected under 35 USC 112, second paragraph, for using the term "disabled" when describing a USB input device, which the specification describes as being able to monitor for password transmissions when in a "locked" state (original specification, page 11, lines 2-4). The Examiner contends that an input device cannot be "disabled" if able to receive an unlocking password signal, and states that "disabled" is the same as "completely disabled." Applicants respectfully disagree.

When read in the context of the cited portion of the specification, it is clear that the "disabled" state is intended to refer to the condition of preventing "data from reaching the USB host controller 30 and the microprocessor" (original specification, page 11, lines 1-2), NOT totally disabling a USB keyboard. That is, the USB input device is disabled to the extent that standard signals are unable to reach the central processor, but the keyboard portion of the input device is still capable of inputting unlocking password signals.

However, in an effort to move the present application to allowance, Applicants have amended Claims 13 and 19 to substitute the term "selectively locked out," as used in the specification, for the term "disabled." As the clarifying term adds no new matter, Applicants now request that these objections be withdrawn.

REJECTIONS UNDER 35 U.S.C. § 103

In paragraph 4.1 of the present Office Action, Claims 13-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kim* (U.S. Patent No. 5,836,010 – "Kim") in view of *Novoa et al.* (U.S. Patent No. 6,223,284 - "Novoa"). In paragraph 5, Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Novoa* in view of *Goff et al.* (U.S. Patent No. 5,835,791 – "Goff"). Applicants respectfully traverse these rejections.

Kim teaches a chip-in card 24 that causes a host controller 28 to disable all input devices, including a keyboard 14 and a mouse 16 (*Kim*, col. 4, lines 17-29). The host controller 28 is unable to selectively disable only the keyboard 14 or mouse 16; rather the keyboard 14 and mouse 16 are either both enabled or both disabled.

Novoa teaches a method and system for remotely flashing a ROM, including the feature of disabling different features of a computer using a Quick-Lock mode option (*Novoa* col. 7, line 58 to col. 8, line 18).

Goff teaches a method and system for routing data from a first keyboard and a second keyboard (*Goff* abstract; *Goff* Claim 10).

EXEMPLARY CLAIM 16

With reference to exemplary Claim 16 (and its dependent claims), the cited prior art does not teach or suggest "disabling, via a first mechanism, a dedicated keyboard coupled to a dedicated keyboard port of a computer while a Power-On-Self-Test (POST) is executing in the computer; and in response to the dedicated keyboard being disabled, disabling, via a second mechanism, a Universal Serial Bus (USB) port on the computer." That is, the cited art, taken alone or in combination, does not teach or suggest disabling a USB keyboard in response to a dedicated keyboard being disabled during a Power-On-Self-Test (POST). Rather, the cited prior art, such as *Kim*, teaches both input devices (such as keyboard 14 and mouse 16) being disabled together, such that the disablement of the second input device (USB port) does not depend on the disablement of the dedicated keyboard.

The Examiner responds in the present office action that this "modification would have been obvious because one skilled in the art would have been motivated to disable a USB port in response to the dedicated keyboard being disabled in order to prevent users from transferring data through the USB interface as a measure of security (see column 7, line 62 through column 8, line 9) as suggested by *Novoa et al.*"

It is axiomatic that the Examiner may not "use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q. 2d 1780 (CAFC 1992). The cited prior art does

not teach, suggest, or provide a motivation to make the disablement of a USB port dependent on disabling the dedicated keyboard. The passage in *Novoa* cited by the Examiner refers to a Quick-Blank mode option that selectively disables various features on a computer, including a keyboard and a USB port. There is no suggestion that any or all of the features are not independently disabled. That is, there is no suggestion that any disablement is dependent on any other disablement.

As the cited prior art does not teach or suggest all of the features of the present invention, nor provide a motivation to modify the prior art to arrive at the present invention, Applicants respectfully request that the rejection of exemplary Claim 16 be withdrawn.

EXEMPLARY CLAIM 13

With reference to exemplary Claim 13 (and its dependent claims), the cited prior art does not teach or suggest “allowing a user input at the input device during POST by at least temporarily overriding the control preventing a user input during the POST if the user successfully satisfies the authorization test,” and a “second input device” that “is selectively locked out only if the first input device is prevented from inputting a signal during the POST.”

The Examiner states that this feature is taught by *Kim* at col. 6, line 62 through col. 7, line 19. However, the cited passage is for claims related to locking and unlocking keyboards according to whether a smart card is inserted into a computer. There is no teaching or suggestion of overriding “user input during the POST” and selectively locking out the second input device “if the first input device is prevented from inputting a signal during the POST.”

With regards to the feature of the “second input device” being disabled only if the “first input device” is disabled, the Examiner cites *Novoa* at col. 11, lines 49-53 for teaching disabling a keyboard and mouse interface. As the cited art does not teach or suggest the “second input device” being disabled only if the “first input device” is disabled, the Examiner states *sua sponte* that this “modification would have been obvious because one skilled in the art would have been motivated to disable a USB port in response to the dedicated keyboard being disabled in order to prevent users from transferring data through the USB interface as a measure of security (see column 7, line 62 through column 8, line 9) as suggested by *Novoa et al.*”

Again, the law is well established with regard to combination of references. The patent Examiner bears the burden of establishing a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. § 103. The mere fact that the references cited by the Examiner may be modified to show the different elements of the claimed present invention does not allow the Examiner to meet his burden, absent a suggestion in the cited art of the desirability of the modification.

As the cited prior art does not teach or suggest all of the features of exemplary Claim 13, Applicants respectfully request a notice of allowance of exemplary Claim 13 and other related pending claims.

EXEMPLARY CLAIM 20

With regards to exemplary Claim 20, the cited prior art does not teach or suggest "monitoring the USB port for an enabling password, the enabling password permitting the dedicated keyboard to be re-enabled." The Examiner cites *Goff* for teaching this feature in *Goff* claim 10. However, *Goff* claim 10 discloses, as does the specification of *Goff*, a method for selecting data from a first or second keyboard according to whether a first or second controller-to-host interface is active. There is no teaching or suggestion of an "enabling password permitting the dedicated keyboard to be re-enabled."

As the cited prior art does not teach or suggest all of the features of exemplary Claim 20, Applicants respectfully request a notice of allowance of exemplary Claim 20 and its dependent claim.

CONCLUSION

For the reasons so stated, Applicants respectfully request a Notice of Allowance for all pending claims.

No extension of time for this response is believed to be necessary. However, in the event an extension of time is required, that extension of time is hereby requested. Please charge any fee associated with an extension of time as well as any other fee necessary to further the prosecution of this application to **IBM CORPORATION DEPOSIT ACCOUNT No. 50-0563**.

Respectfully submitted,



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